The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER JAMES NASON, CRAIG FRISHCH
and ANDRE MOSKAL

Appeal 2007-1127
Application 09/800,112
Technology Center 2100

Decided: June 1, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO
and ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 22-41. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants invented a method of controlling Internet Protocol (IP) telephones within a local area network (LAN) implemented or Ethernet PBX (private branch exchange). (Specification 1:6-8). Specifically, the method uses a general message template consisting of a Protocol Header and an IP Message body where the Protocol Header includes an indication of the Protocol Type, Device Number, and Message Type. (Specification 1:28-30).

Representative independent claim 22 under appeal reads as follows:

> 22. A method of communication between an IP phone and a network-implemented PBX comprising:
>
> generating a message to be exchanged between said IP phone and said PBX;
>
> encapsulating said message with a Protocol Header and an IP Message body, wherein the Protocol Header includes an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP [sic] message, a Device Number for denoting by means of MAC (Media Access Control) an address within said PBX to which said message is to be transmitted or from which said message is to be received, and Message Type for identifying the type of message contained in the IP Message Body; and,
>
> transmitting the encapsulated message.

The Examiner rejected claims 22-41 under 35 U.S.C. § 103(a).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Thornton	US 6,363,065 B1	Mar. 26, 2002
Matsumoto	US 2001/0026545 A1	Oct. 4, 2001

Additional prior art cited by the Board is:

Baroudi	US 6,430,196 B1	Aug. 6, 2002

Appellants contend that the claimed subject matter would not have been obvious. More specifically, Appellants contend that (Suppl. Br. 5):

> Nowhere in Thorton [sic] can one skilled in the art find any teaching or suggestion for use of a Protocol Header as defined relative to claim 22. Claim 22 requires a Protocol Header that has an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, the Protocol Header encapsulating the message. This is important for identifying which of multiple messaging protocols is contained within the encapsulated message (i.e. an IP message or a non-IP (e.g. legacy-PBX) message). By defining the Protocol Type within the Protocol Header, call control functionality from legacy-PBX systems may be extended to an Ethernet or LAN-implemented PBX. Absent the teaching or suggestion for encapsulating a message with such a Protocol Header, claims 22-41 are not obvious in view of the proposed combination of references.

The Examiner contends that it would have been obvious to incorporate a Protocol Type because (Answer 12):

> "*[I]t is very well known in the networking art that there is a Protocol field, which specifies the type of the encapsulated protocol, in the IP packet header as defined by the TCP/IP*

> *protocol suite.*" It is well known in the networking art that the protocol field identifies "*which protocol gave the data for IP to send*". (TCP/IP Illustrated, Volume 1 - The Protocols, W. Richard Stevens, 1994, pages. 34-37, figure 3.1).

Appellants further contend that the Examiner's contention, "does not equate with identifying whether a message is IP or non-IP" and "[t]he Examiner has apparently failed to give due consideration to the plain words of the claim" (Reply Br. 3).

We affirm.

ISSUE(S)

Have Appellants shown that the Examiner has failed to establish one skilled in the art would have incorporated Thornton's IP message encapsulating into Matsumoto's IP network in such a manner as to obtain a "Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message" as required by claim 22?

FINDINGS OF FACT

Appellants invented a method of controlling Internet Protocol (IP) telephones within a local area network (LAN) implemented or Ethernet PBX (private branch exchange). (Specification 1:6-8). Specifically, the method uses a general message template consisting of a Protocol Header and an IP Message body where the Protocol Header includes an indication of the Protocol Type, Device Number, and Message Type. (Specification 1:28-30).

The Protocol Type denotes whether the message is an IP message (e.g. Mitel proprietary Minet IP message) or an encapsulated non-IP

message (e.g. Mitel proprietary Minet (MTS 22) message).

(Specification 2:3-5).

Thornton describes a Protocol field, which specifies the type of the encapsulated protocol (Col 24, ll. 59-67).

> In particular, process 535 accepts incoming IP packets from the LAN, as supplied by Ethernet driver 533. In that regard, each of these packets, as conventionally occurs, was encapsulated, as payload data, within an Ethernet packet and is extracted therefrom by the Ethernet driver. As such, process 535 routes the IP packet to either one of the local applications or protocols for processing, based on a protocol ID and well-known port number contained within the packet.

Thus, Thornton describes plural protocols and a protocol ID, in the packet, which denotes whether the encapsulated message (message body) is a first type of message or a second type of message.

A message body is non-functional descriptive material in that unlike the Protocol Header it does not change the functionality of the communication system.

PRINCIPLES OF LAW

On appeal, Appellants bear the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of Matsumoto with those of Thornton.

Appellants may sustain this burden by showing that, where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art

would have done what Appellants did. *United States v. Adams*, 383 U.S. 39 (1966); *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006).

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

§ 103 ANALYSIS

Appellants correctly point out the Examiner premised the rejection on incorporation of a "well-known" networking Protocol field into Thornton's IP message encapsulating. However, as we note in our Findings of Fact, Thornton explicitly describes using a "protocol ID". Thus, the Examiner's introduction of the "well-known" networking feature is redundant to the teachings of Thornton.

Therefore, the sole issue before us is whether Appellants' claimed "Protocol Type" distinguishes over the prior art protocol field or protocol ID based on the claimed functionality of "denoting whether the message is an IP message or an encapsulated non-IP message". As we have already found Thornton describes plural protocols and a protocol ID, in the packet, which

denotes whether the encapsulated message is a first type of message or a second type of message. Thus the issue before us is further reduced to whether Appellants functionally or structurally distinguish over the prior art by specifying that the prior art first type of message is "an IP Message" and the prior art second type of message is "an encapsulated non-IP message."

We conclude that they do not. We find that Matsumoto and Thornton teach all the claimed functionality and structure of claim 22. We find that Appellants' IP message and encapsulated non-IP message are nonfunctional descriptive material. Therefore, we must conclude that the difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

Appellants' argue that in their claim, "call control functionality from legacy-PBX systems may be extended to an Ethernet or LAN-implemented PBX." We note that no such limitation is present in the claims. Rather, Appellants' claims are limited to message generating, transmitting, and the format of the message. We find no claim limitations directed to "call control functionality" as argued.

OTHER ISSUES

The Board brings to Appellants' and the Examiner's attention the Baroudi patent cited above. Should there be further prosecution of the present or a continuing application, we recommend a review of Baroudi's Figures 2, 5, and 11.

CONCLUSION OF LAW

(1) Appellants have failed to establish that the Examiner erred in rejecting claims 22-41 as being unpatentable under 35 U.S.C. § 103(a) over Matsumoto and Thornton.

(2) Claims 22-41 are not patentable.

DECISION

The Examiner's rejection of claims 22-41 is Affirmed.

AFFIRMED

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